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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/028,129

12/20/2001

Christine J. Landry-Coltrain

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09/13/2006

Paul A. Leipold  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/028,129

Applicant(s)

LANDRY-COLTRAIN ET AL.

Examiner

Pamela R. Schwartz

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 6-9, 11-43 is/are pending in the application.
- 4a) Of the above claim(s) 26-28 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9,11-25 and 29-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 20060909.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-9, 11, 19-25, 34, 35 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Okumura et al. (5,360,780) for reasons of record and for reasons given below. With respect to amendments to claim 1 requiring the ink receiving layers to be hydrophilic and to contain polymeric binder, this is taught by the reference at col. 9, lines 28-33.

2. Claims 1, 2, 6-9, 11-25, 33-39, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (5360780) for reasons set forth above and for the following reasons. With respect to claim 18, since the reference has a glossiness and teaches controlling this property in col. 13, it would have been obvious to one of ordinary skill in the art to select particles that result in the desired level of glossiness.

3. Applicant's arguments filed June 26, 2006 have been fully considered but they are not persuasive. Contrary to applicants' assertions, Okumura et al. disclose that the mean particle size of the thermoplastic resin fine particle aggregate ranges from 0.2 to 20 microns and that the particle size is substantially uniform (see col. 5, lines 52-67 and col. 9, lines 7-19). Therefore, at the bottom end of the disclosed range, the limitation of claim 1 will be met by the reference. The examiner also disagrees with applicants' assertions that merely because an ink jet recording element is claimed, and the reference is directed to an image-receiver for thermal transfer, the elements are non-

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analogous and the medium of the reference will not be capable of receiving ink jet ink.

The determination as to whether the material will function as an ink jet recording element must be made based upon the disclosed materials rather than based upon the title given to the element. In this case, the reference discloses layers of hydrophilic binder and porous particles. These layers are inherently hydrophilic and therefore, the medium will function as an ink jet recording element. In addition, applicants 5<sup>th</sup>

Declaration is unpersuasive as it is directed to a comparison of two specific media, neither of which is the medium of the applied prior art or the invention. Because one thermal record receiver is hydrophobic does not mean that all such elements are hydrophobic.

There is no inherent structure in the term "ink jet recording element" beyond a capability of being imaged with an inkjet recording apparatus. Since both ink compositions and apparatuses vary widely, the scope of what can be imaged with such an apparatus also may vary. Applicants' reliance on the classification schedule is not well founded. At the time Okumura et al. was issued, 428/32.34 did not exist. All of the recording media patents were classified in 428/195 based upon a discontinuous coating. This is a subclass where the Okumura et al. patent was crossed. The searches for these inventions would have overlapped because they are related. Subclasses 428/32.1-32.38 were created to help with searching when the subclass 428/195 was difficult to search because it had well over 4000 patents. This does not void the link between these materials. In addition, it is common in the art to claim "an imaging element" that can be imaged by different imaging mechanisms. It is noted that

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part of the reclassification created a subclass to capture elements intended to be "universal" media or media intended to be used with multiple imaging systems. Overlap is common. In fact, the instant assignee has numerous patents to media that are specifically claimed or disclosed as useable with different imaging systems. The only true way to distinguish image receptor materials is by the compositions of the materials disclosed. In this case, the materials of Okumura et al. are consistent with use as an ink jet recording material.

Gloss as a desired property is something that would be shared between different printing mechanisms. The gloss is a property of the final printed product. An end user will not consider the method by which the image is formed, but rather, how the image appears to them. Consequently, that the reference discloses the importance of controlling gloss makes it obvious to optimize gloss in the final product. The desired result won't change based upon the printing mechanism.

The examiner has review applicants' showings in the specification and declarations, but finds them insufficient to demonstrate criticality of the limitation of claim 1 that 68% of the porous polyester particles have a diameter of less than 0.5 micrometers. The showings do not specifically support 68% as a critical endpoint to the range.

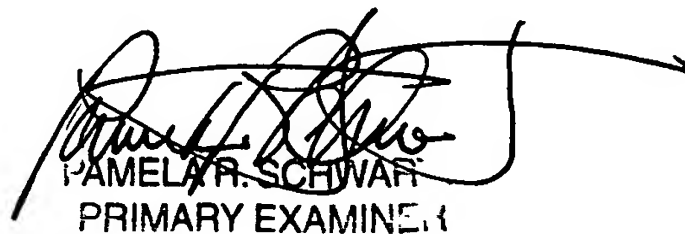
It is noted that during a telephone interview, it was discussed that the support for the limitation of claim 1 is unclear from the specification. This limitation is the result of values taken from the specification and statistical analysis of these values. Applicants will amend the specification so that it sets forth the statistical support for this limitation.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
September 9, 2006

  
PAMELA R. SCHWARTZ  
PRIMARY EXAMINER